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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,834	01/15/2004	Dale A. Burghardt	KCX-119-CON (14175.1)	5079
22827	7590	05/03/2006	EXAMINER	
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,834

Applicant(s)

BURGHARDT ET AL.

Examiner

James W. Rogers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 12 between claims 3 and 5 has been renumbered to 4.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-14, 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Goulet et al. (US 6,054,020).

Goulet teaches amine modified polysiloxanes and non-amino polysiloxanes compositions applied to the surface of a tissue product, the siloxane treatment can contain a biocide (meets the beneficial chemical limitation since it's an antimicrobial), also integers X and Y and their ratios are within the applicants specified range, all of the R groups for the amino and nonamino-polysiloxanes are the same as those claimed by

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applicant. See abstr, col 1 lin 26-48, col 3 lin 4-67, examples, claims 1,10-13. Regarding the limitation in claims 1 and 13 that the paper product is capable of transferring a beneficial chemical compound to an opposing surface is met because the tissue contains the same siloxane treatment as applicant plus a chemical agent, because the two siloxane treatments are the same they will both be able to transfer chemical agents to an opposing surface. Regarding claim 4 the viscosity requirement is met, see col 4 lin 1-5. Regarding Claim 6 the limitation that the siloxane treatment comprises an emulsion is met, see col 2 lin 39-44. Regarding claim 7 and 18 the limitation that the polysiloxane treatment is printed is met, see col 4 lin 6-8. The limitation of the siloxane treatment percent by weight in claims 9-10 and 19-20 are met because Goulet teaches the weight percent of siloxane on the tissue can be 0.1-5% within the range specified by applicant. Regarding claims 12 and 22 it is inherent that since Goulet teaches that the amine on the polysiloxane can contain alky chains thus the amino functional group would be generally hydrophobic, see col 3 lin 36-61. Regarding claim 13 the limitation that the nonwoven web has a basis of weight form about 4-40 pounds is met because the Goulet patent uses a tissue with a finished basis weight of 22.7 pounds and list several commercial tissues which can be used for the invention, the burden is shifted to the applicants to show that the facial tissue in the Goulet patent does not the same tissue weight.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goulet et al. (US 6,054,020).

Goulet teaches as above. Regarding claim 8 it would have been obvious to someone skilled in the art at the time of the invention to add two different beneficial chemical agents to the tissue, since the Goulet patent already teaches the addition of a biocide, one would have a reasonable chance of success by simply adding more chemical agents to the siloxane treatment. Regarding claims 15-16 the Goulet patent does not specifically disclose a polysiloxane comprising a methyl dimethyl group, it is

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however encompassed within scope of the specification and claims since groups  $R_1$ - $R_9$  on the polysiloxane can comprise alkyl moieties especially  $C_1$ - $C_4$ .

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Goulet to devise a soft tissue paper treated with a siloxane composition containing two beneficial chemical agents and a polysiloxane containing a methyl dimethyl group. Therefore the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floyd (EPA 0607796A1).

Floyd discloses nonwovens of cellulose fibers used as face towels comprising 45-98% of a polyether polysiloxane, 1-20 % of an amino functional siloxane and other polysiloxanes and further comprising other components (preservatives, dyes and perfumes). See pg 3 lin 1-20. Floyd discloses that the polysiloxane composition can be sprayed, imprinted or printed on the nonwoven material. See pg 3 lin 21. Floyd also discloses that when the composition is used as a face towel, a thin film portion of the composition remains on the skin. See pg 9 lin 40-43.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Floyd to devise a soft facial tissue, which can impart a pleasant feeling to the skin. Because the teachings of Floyd, that interwovens of cellulose fibers treated with a composition of polysiloxanes comprising an active agent that can be used to impart to the skin, skincare substances,

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which in turn have a softening and smoothing effect on the skin, one of ordinary skill in the art would have a reasonable expectation that the paper products and facial tissues claimed in the instant application would be successful. Therefore the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ampulski (US 5,389,204).

Ampulski provides a process for making soft tissue paper comprising a functional polysiloxane blended with a non-volatile solvent and emulsified and includes amino and polyether functional polydimethylsiloxanes among the preferred polysiloxanes used in the invention. See col 3 lin 30-col5 lin 3. Ampulski discloses that suitable non-volatile diluents are preferably compositions of nonfunctional polydimethyl siloxanes, mineral oil, surfactant and an active agent that enhances smoothness. See col 5 lin 8-22. Ampulski teaches that the fibers utilized in the invention comprise wood and other cellulose pulp fibers and the viscosity of the polysiloxane is 25-20,000,000 centistokes. See col 10 lin 20-29 and col 12 lin 43-56. Ampulski discloses that the polysiloxanes are applied from the emulsion to either side of the tissue or to both sides and the methods include spraying and printing with a weight % of .75. See col 15 lin 60-col 16 line 20 and col 19 lin 30-52.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to apply the teachings of Ampulski to devise a soft facial tissue, which imparts a pleasant feeling to the skin. The expected result would have

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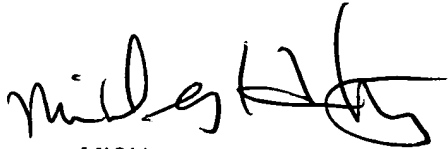
been a successful paper product or facial tissue capable of transferring beneficial compounds to the skin. Because of the teachings of Ampulski, that composition of polysiloxanes comprising active agent can be applied to either side of the tissue web to make a soft tissue paper, one of ordinary skill in the art would have a reasonable expectation that the paper products and facial tissues claimed in the instant application would be successful. Therefore the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER